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Re: Appeal Brief
Attorney Docket No: 0233-0001
Serial No: 10/633,262

NOTES/COMMENTS:

Title of Invention: **Racing Sulky**

Inventor: **Thomas G. HARMER**

Contents:

Transmittal Form (1 page)

Appeal Brief (14 pages)

Fee Transmittal Form (1 page)

Credit Card Form (1 pages)

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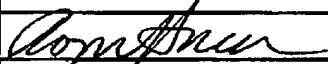
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TRANSMITTAL FORM <small>(to be used for all correspondence after initial filing)</small>	Application Number	10/633,262	
	Filing Date	July 31, 2003	
	First Named Inventor	Thomas HARMER, et al.	
	Art Unit	3618	
	Examiner Name	John Walters	
Total Number of Pages in This Submission	18	Attorney Docket Number	0233-0001

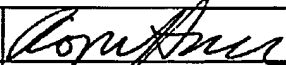
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APPELLANT'S BRIEF

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APR 07 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Thomas G. HARMER, et al.

Title: Racing Sulky

Serial No: 10/633,262

Filing Date: July 31, 2003

Art Unit: 3618

Examiner: John Walters

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Appellant's Brief 37 C.F.R. 41.37

Real party in interest

The real party in interest is assignee Evolution Racing, L.L.C.

Related appeals and interferences

There are no related appeals or interferences.

Status of claims

1. Allowed
2. Rejected
3. Allowed
4. Allowed
5. Rejected
6. Rejected

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7. Allowed
8. Allowed
9. Rejected
10. Rejected
11. Rejected
12. Rejected
13. Allowed
14. Rejected
15. Rejected
16. Rejected
17. Rejected

Claims 2, 5-6, 9-12 and 14-17 are being appealed.

Status of amendments

No amendment after final was filed by applicants.

Summary of claimed subject matter

The numbers in brackets indicate a paragraph of the specifications in which the parts is (are) described.

Claim 2 calls for a sulky to be drawn by a horse, comprising:

a generally tubular arch 14 having two ends [0016];

a seat 22 mounted to said arch between said ends [0016];

a pair of strut assemblies 40 [0018] depending downwardly from and weldable to generally opposite ends of said arch, each of said strut assemblies for receiving a wheel 16 [0018];

a pair of rails 24, 26 [0017] mounted to said arch, one rail being mounted on one side of said seat and the other rail being mounted on the other side of said seat, each of said rails extending generally in a longitudinal direction from said arch to a distal end 32, 34 [0017], said distal ends of said rails being adapted for harnessing said horse between said rails;

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wherein said arch and said strut assemblies are positioned for substantially longitudinal alignment of said wheels before welding said strut assemblies to said arch.

Claim 3 calls for a sulky to be drawn by a horse, comprising:

a generally tubular arch 14 having two ends [0016];

a pair of laterally spaced wheels 16 [0016] mounted generally at opposite ends of said arch;

a seat 22 [0016] mounted to said arch between said ends and said wheels;

a pair of rails 24, 26 [0017] mounted to said arch and extending forwardly, one of said rails being mounted to said arch on one side of said seat, and the other of said rails being mounted to said arch on the other side of said seat, each rail having a proximal portion 66 a, b [0042] mounted to the arch and a distal portion 68 a, b [0042] pivotally connected to said proximal portion so that said distal portion can pivot toward and away from said horse with respect to said proximal portions;

each of said distal portions having a distal end 32, 34 [0017] adapted for harnessing said horse between said rails.

Claim 5 calls for a sulky to be drawn by a horse, comprising:

a pair of laterally spaced wheels 16 [0016] mounted generally at opposite ends of a generally tubular arch 14 [0016], there being a longitudinal center line 2 [0020] between said pair of wheels;

a seat 22 [0016] mounted to said arch between said ends and said wheels;

a first rail 24 [0017] and a second rail 26 [0017] extending from said arch, each rail having a proximal end 28, 30 [0017] mounted to said arch and a distal end 32, 34 [0017] adapted for harnessing to said horse, said first rail being mounted to said arch on one side of said seat and said second rail being mounted to said arch on the other side of said seat;

wherein a portion AB [0038] of said first rail proximate said arch is angled toward said center line as said portion extends from said arch, and wherein a longitudinal center line 4 between said distal ends is offset from said longitudinal center line between said pair of wheels.

Claim 7 calls for a sulky to be drawn by a horse, comprising:

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a pair of laterally spaced wheels 16 [0016] mounted generally at opposite ends of a generally tubular arch 14 [0016], there being a longitudinal center line 2 [0020] between said pair of wheels;

a seat 22 [0016] mounted to said arch between said ends and said wheels;

a first rail 24 [0016] and a second rail 26 [0016] extending from said arch, each rail having a proximal end 28, 30 [0017] mounted to said arch and a distal end adapted for harnessing to said horse, said first rail being mounted to said arch on one side of said seat and said second rail being mounted to said arch on the other side of said seat;

wherein a portion FG [0038] of said first rail proximate said arch is angled toward said center line as said portion extends from said arch so that a longitudinal center line 4 [0036] between said distal ends is offset from said longitudinal center line between said pair of wheels, and

wherein said portion FG of said first rail proximate to said arch is angled at a first angle γ [0038] toward said center line as said portion extends from said arch and a portion AB [0038] of said second rail proximate said arch is angled at a second angled angle δ [0038] toward said center line as said portion of said second rail extends from said arch, wherein said first angle is larger than said second angle.

Claim 9 calls for a sulky to be drawn by a horse, comprising:

a generally tubular arch 14 [0016] having two ends;

a seat 22 [0016] mounted to said arch between said ends;

a pair of rails 24, 26 [0016], one rail being mounted to said arch on one side of said seat, the other rail being mounted to said arch on the other side of said seat, said rails extending in a generally longitudinal direction from said arch to distal ends 32, 34 [0017], said distal ends of said rails being adapted for harnessing said horse between said rails;

a pair of laterally spaced wheel assemblies 87 [0029] mounted generally at opposite ends of said arch;

wherein each of said wheel assemblies 87 includes a wheel 16 having two sides 88, 90, a set of tubular spokes 92 [0029], a rim 94 [0029], and a pair of substantially planar covers 98, 100 [0029] mounted on opposite sides of said wheel and substantially covering said spokes.

Claim 10 calls for a wheel assembly for a sulky to be drawn by a horse, comprising:

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a wheel 16 [0016] having two sides 88, 90 [0029] , a set of tubular spokes 92 [0029] , and a rim 94 [0029]; and
a pair of substantially planar covers 98, 100 [0029] mounted on opposite sides of said wheel and substantially covering said tubular spokes.

Claim 13 calls for a sulky to be drawn by a horse, comprising:

a generally tubular arch 14 [0016] having two ends;
a pair of laterally spaced wheels 16 [0016] mounted generally at opposite ends of said arch;
a seat 22 [0016] mounted to said arch between said ends and said wheels;
a pair of rails 24, 26 [0016] mounted to said arch and extending forwardly, one of said rails being mounted to said arch on one side of said seat, and the other of said rails being mounted to said arch on the other side of said seat, each rail having a proximal portion 66 a, b[0042] mounted to the arch and a distal portion 68 a, b [0042] pivotally connected to said proximal portion so that said distal portion can pivot with respect to said proximal portions;
each of said distal portions having a distal end 32, 34 [0017] adapted for harnessing said horse between said rails;
wherein said distal end of each distal portion moves over a predetermined lateral range of between about 4 inches and about 4 ½ inches when said distal portion pivots with respect to said proximal portion. [0047]

Grounds of rejection to be reviewed on appeal

Claims 10 and 11 stand rejected under 35 U.S.C. § 102 as being allegedly anticipated by Gaines et al. (U.S. Patent 3,103,369).

Claim 2 stands rejected as being allegedly unpatentable under 35 U.S.C. § 103 over King (U.S. Patent 4,033,598).

Claims 5,6 and 14-17 stand rejected as being allegedly unpatentable under 35 U.S.C. § 103 over Stein et al. (U.S. Patent 4,033,598) in view of WO 93/19969.

Claim 9 stands rejected as being allegedly unpatentable under 35 U.S.C. § 103 over Gaines et al. (U.S. Patent 3,103,369) in view of Stein et al. (U.S. Patent 4,033,598).

Claim 12 stands rejected as being allegedly unpatentable under 35 U.S.C. § 103 over Gaines et al. (U.S. Patent 3,103,369).

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Argument

The cited Patents fail alone or in any proper combination, to teach or suggest Applicants' invention as claimed in the appealed claims. Accordingly, it is respectfully requested that the rejections of record be reversed, and the claims be allowed.

Claim Rejections – 35 U.S.C. § 102

Turning now to the claim rejections as to anticipation under 35 U.S.C. § 102, claims 10 and 11 stand rejected as being allegedly anticipated by Gaines, et al. (U.S. Patent 3,103,369). Gaines is cited for a "wheel assembly for a sulky" having a wheel, a set of tubular spokes having a circular cross-section, a rim; and a pair of substantially planar covers.

Claim 10 is patentable over Gaines because Gaines describes a single wheel cover for covering both sides of a wheel, not a pair of wheel covers, as claimed in claim 10. Gaines does not disclose a pair of wheel covers which are mounted to the wheel, as claimed in claim 10. Rather, Gaines appears to describe a "kick guard" 14 (col. 2, ll. 62-69) which is a "rigid unitary assemblage" (col. 3, ll. 8-9) and fixed to the sulky frame by a strap 29 (col. 3, ll. 35-41) and is mounted not to the wheel, but is sandwiched between nuts 20, 21 and the outer races of the wheel bearings 22, 23 (col. 3, ll. 10-15)

Moreover, Gaines does not describe "substantially planar wheel covers" as claimed in claim 10. The Gaines kick guard is shaped substantially like a hollow disc to fit over the wheel. The side walls 15, 16 of this kick guard 14 are frustoconical, i.e., bowed out at their centers. Additionally, the kick guard disclosed by Gaines does not cover the spokes at the bottom of the wheel. In contrast, claim 10 requires that the pair of planar wheel covers "substantially" cover the spokes. For at least these reasons, the invention claimed in claim 10 is patentable over Gaines. Accordingly, it is respectfully requested that the rejection be reconsidered and claim 10 allowed.

Claim 11 depends from claim 10 and is allowable for the same reasons as claim 10, plus the additional limitation of the covers being mounted to the wheel using fasteners. Accordingly, it is respectfully requested that the rejection be reconsidered and claim 11 allowed.

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Claim Rejections – 35 U.S.C. § 103

Turning now to the claim rejections as to obviousness under Section 103, claim 2 is rejected under 35 U.S.C. § 103(a) as being allegedly anticipated by King (US patent 4,033,598). Claim 2 is patentable over King because King does not teach longitudinal alignment of the strut assemblies before welding of the strut assemblies to the arch, as called for in claim 2. The Examiner admits that King does not teach that the arch and the strut assemblies are positioned for substantially longitudinal alignment of the wheels before welding. No other reference (or other basis, other than the Examiner's opinion) is cited to supply this teaching, which is found only in Applicant's disclosure. Accordingly, it is respectfully requested that the rejection be reconsidered and claim 2 allowed.

Claims 5 and 6 and 14-17 stand rejected under 35 U.S.C. § 103a as being allegedly unpatentable over Stein et al. in view of WO 93/19969. Stein discloses a racing sulky having angled rails but does not teach or suggest an offset. WO 93/19969 discloses an offset but does not teach or suggest a rail having a portion near the arch that is angled inwardly.

In the final office action, the Examiner stated in the rejection of claim 5 "It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to combine the offset center lines of WO 93/19969 with the sulky of Stein in order to allow said sulky to be made shorter, thereby improving speed, while allowing the horse to not contact the "outboard" wheel when rounding a turn on the racetrack." However, applicant neither claims nor discloses making the sulky shorter or improving speed. Accordingly, one of ordinary skill in the art motivated by these considerations would not turn to these references, or achieve applicants' claimed structure.

In the Examiner's "Response to Arguments" in the final office action, the Examiner has stated "WO 93/19969 teaches that it is advantageous for a variety of reasons to manufacture a sulky rail which angles inwardly causing an offset center line (page 5, line 25 to page 6 line 2)." However, the cited portion of the reference, and the reference as a whole, is devoid of any teaching or suggestion to "manufacture a sulky rail which angles inwardly causing an offset center line".

Claim 5 is patentable over Stein in view of WO/93 19969 because neither reference taken singly, or in any proper combination, teaches or suggests an offset racing sulky wherein at least one rail has a portion near the arch that is angled inwardly. The references cannot properly be

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combined in the absence of a clear teaching, suggestion or motivation to combine the references in a manner that would result in the claimed invention instead of any of an infinite number of possibilities. The suggestion comes only from Applicant's disclosure which cannot be used to reject Applicant's claims under 35 U.S.C. 103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F. 2d 1561 (Fed. Cir.1987). Thus, the Examiner has not presented a prima facie case that the invention as claimed would have been obvious to one of ordinary skill in the art at the time the invention was made.

There being no prima facie case of obviousness, properly speaking, there is no burden on Applicant to overcome the rejection, nevertheless, should it be deemed relevant or necessary, there is an abundance of objective evidence of non-obviousness, namely, long-felt need, unexpected and surprising results, commercial success, and copying by others.

The Rule 132 Declaration of Thomas G. Harmer, submitted herewith, indicates *long-felt need* for the invention of claim 5, because even though WO/93 19969 (published in 1993) purported to disclose an offset racing sulky, neither it nor any other offset sulky appears to have been accepted in harness racing. Harmer Decl. ¶ 4. Similarly, Stein's angled-rail sulky, despite having been in public use since about 1998, failed to prompt anyone, until Harmer, to make the invention of claim 5.

Informed by 20-plus years of experience, Harmer declares "I knew of existing sulkies but was not satisfied with any of them, which led me to make the invention of claim 5, having a priority date of July 31, 2003, which I believe to be the first sulky to incorporate the advantage of an angled rail and an offset." Harmer Decl. ¶ 7. "The invention of claim 5 was immediately accepted and embraced by the harness racing industry." Harmer Decl. ¶ 8. Such long-felt need is evidence of non-obviousness. *Micro Chem., Inc. v. Great Plains Chem. Co.*, 103 F.3d 1538 (Fed. Cir. 1997).

The Harmer Declaration also proves that "[t]he invention of claim 5 has achieved *unexpected and surprising results* in that the harness racing sulkies of claim 5 have won so many races by such large margins that competitors have refused to race prior art sulkies against the claimed sulkies." Harmer Decl. ¶ 9. Unexpected and surprising results may establish non-obviousness. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985).

The Harmer Declaration further establishes that "[t]he invention of claim 5 has achieved outstanding *commercial success* in that in the past 12 months [Harmer's] company sold more

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than 350 sulkies covered by the claims...[representing] more than 80% of the total market.” Harmer Decl. ¶ 10. “The invention of claim 5 was immediately accepted and embraced by the harness racing industry.” Harmer Decl. ¶ 8. “Sales of prior art sulkies declined sharply and have languished since I introduced the sulky of claim 5.” Harmer Decl. ¶ 11. Commercial success, when linked to the features of the claimed invention, may prove non-obviousness. *Graham v. John Deere*, 383 U.S. 1, 12 (1966).

The Harmer Declaration further establishes that “[t]here are many manufacturers of harness racing sulkies” and that “several of them have copied the invention of claim 5.” Harmer Decl. ¶ 12. Copying by competitors of the claimed invention is an indicator of non-obviousness. *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 991 (Fed. Cir. 1988).

In response to the Harmer declaration, in the final office action, the Examiner states only as follows: “While the Office appreciates the information provided by Applicant in the Rule 132 Declaration, it does not overcome the rejection based on the prior art.” It is submitted that this statement fails to meet the obligation imposed by the case law, regarding the relevance and consideration to be given to declarations under Rule 132.

The U.S. Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), established the importance of such factors as evidence to be considered in determining obviousness. Although still sometimes called ‘secondary considerations,’ the Federal Circuit has made it clear secondary considerations, now called ‘objective evidence of nonobviousness’ (“objective evidence”), must be considered in obviousness determinations if presented. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555 (Fed. Cir. 1983); *see also, Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39 (Fed. Cir. 1983). The Federal Circuit elaborated on the importance of objective evidence in *W.L. Gore* as stated here,

“The objective evidence of nonobviousness, i.e., the “indicia” of *Graham*, may in a given case be entitled to more weight or less, depending on its nature and its relationship to the merits of the invention. *It may be the most pertinent, probative, and revealing evidence available to aid in reaching a conclusion on the obvious/nonobvious issue. It should, when present, always be considered as an integral part of the analysis.*” (emphasis added)

It is Patent Office (“PTO”) policy to consider objective evidence in considering and determining obviousness. MPEP § 2141, *see also* MPEP § 2144.08 paragraph II.B. Examiners are instructed to apply the four factual inquiries, which includes evaluating objective evidence.

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(a) determine the scope and contents of the prior art; b) ascertain the level of ordinary skill in the pertinent art; c) resolve the level of ordinary skill in the pertinent art; and d) evaluate evidence of secondary considerations). The MPEP requires examiners to accord weight to such evidence as depends on the individual circumstances of each case, depending on its relevance to the issue of obviousness and the amount and nature of the evidence. MPEP § 716.01(b), defining 'nexus' as designating a factually and legally sufficient connection between the objective evidence and the claimed invention so that the evidence is of probative value in the determination, *see Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387 (Fed. Cir.) *cert denied*, 488 U.S. 956 (1988).

All evidence *must* be considered before a conclusion on obviousness is reached. *Lindermann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1461 (Fed. Cir. 1984).

When examiner reconsiders the patentability of the invention, the ultimate determination is to be based on the *entire record*, by a preponderance of evidence standard, with due consideration to the persuasiveness of any arguments and any objective evidence.¹ *In re Piasecki*, 745 F.2d 1468 (Fed. Cir. 1984) states that when prima facie obviousness is established and objective evidence is submitted in rebuttal, the decision-maker must start over.² An earlier decision of the invention being obvious should not be considered as set in concrete, and therefore applicant's rebuttal evidence should not be evaluated only for countering the earlier decision.³ Analytical fixation on an earlier decision can tend to provide that decision with an undeservedly broadened umbrella effect.⁴ Prima facie obviousness is a legal conclusion, not a fact.⁵ Facts established by rebuttal objective evidence must be evaluated along with the facts on which the earlier conclusion was reached, not against the conclusion itself.⁶ A final finding of obviousness must rest upon evaluation of all facts in evidence, uninfluenced by any earlier conclusion reached by an earlier board upon a different record.⁷ *In re Piasecki*, states "evidence of secondary considerations may often be the most probative and cogent evidence in the record. It

¹ MPEP §716.01(d).

² *In re Piasecki*, at 1472.

³ *Id.*

⁴ *Id.*

⁵ *Id.*

⁶ *Id.*

⁷ *Id.*

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may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decision-maker remains in doubt after reviewing the art.”⁸

All entered affidavits, declarations, and other evidence traversing rejections are to be acknowledged and commented upon in the next succeeding action.⁹ Little comment is necessary if the evidence is sufficient to overcome the rejection.¹⁰ However, in determining the evidence insufficient, the examiner *must* specifically explain why the evidence is insufficient and merely providing general statements such as “the declaration lacks technical validity” or the evidence is not commensurate with the scope of the claims” is not enough.¹¹

Examples of objective evidence include: 1) unexpected results, 2) commercial success, 3) long-felt need, 4) failure of others, 5) skepticism of experts, 6) copying, and 7) licensing.¹² Specifically on unexpected results, an applicant must present evidence, such as relevant comparative data, not merely argument, to demonstrate the evidence is not obvious when compared to the closest prior art.¹³ With regard to commercial success, evidence is strictly scrutinized in the PTO, therefore, information on market share, growth in market share, replacement of earlier products sold by others, etc. must be submitted.¹⁴ For long-felt need, submitting evidence of long-felt need through affidavit of an expert having first hand knowledge of the field is considered a strong indicator of nonobviousness.¹⁵

In summary, Graham established that objective evidence of nonobviousness can be considered in determining nonobviousness.¹⁶ The Federal Circuit has stated such evidence must be considered when presented and will be given the weight it deserves according to its nature and

⁸ *Id.* at 1475.

⁹ *Id.*

¹⁰ MPEP § 716.01.

¹¹ *Id.*

¹² MPEP §§ 716.02-716.06; *see also*, MPEP § 2144.08 paragraph II.B. for a discussion on reviewing such rebuttal evidence.

¹³ *In re Case*, No. 98-1531, 1999 WL 682875, at II.A. (1999 U.S. App. LEXIS 20827, at 9) (Fed. Cir. 1999).

¹⁴ *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1151 (Fed.Cir.1983) (upholding the district court’s invalidity ruling and holding the patent obvious when “the evidence of commercial success consisted solely of the number of units sold”).

¹⁵ *Matter of Mahurkar Double Lumen Hemodialysis Catheter Patent Litigation* 831 F.Supp. 1354, 1378 (N.D.Ill.,1993) (*stating*, “The existence of an enduring, unmet need is strong evidence that the invention is novel, not obvious, and not anticipated. If people are clamoring for a solution, and the best minds do not find it for years, that is practical evidence-the kind that can’t be bought from a hired expert, the kind that does not depend on fallible memories or doubtful inferences-of the state of knowledge.”)

¹⁶ *supra*, 383 U.S. 1 (1966).

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its nexus with the claimed invention.¹⁷ The MPEP states the Federal Circuit's position that objective evidence must be considered, given its appropriate weight, and examiners are to respond to presented objective evidence in a detailed manner if it is still determined to be obvious.¹⁸

Accordingly, it is respectfully requested that the rejection be reconsidered and that claim 5 be allowed.

Claim 6 depends from claim 5 and is patentable for the same reasons as claim 5 plus the limitation of a rail portion being angled at an angle of about 15 degrees. Stein and WO 93/19969 do not teach or suggest, singly or in any proper combination, an offset racing sulky wherein one rail is angled at an angle of about 15 degrees. Accordingly, it is respectfully requested that the rejection be reconsidered and that claim 6 be allowed.

Claim 14 depends from claim 5, and is patentable for the same reasons as claim 5, plus the limitation of a portion of the second rail proximate the arch angled toward the wheel centerline.

Claim 15 depends from claim 14, and is directed to each rail including a second portion extending forwardly from the angled portion, a second angled portion extending forwardly from the second portion, wherein a stirrup is located on each second portion behind the second angled portion.

Claim 16 depends from claim 14, wherein each of said rails comprise an inwardly angled portion proximate said arch, a generally longitudinal stirrup-holding portion, an inwardly angled intermediate portion, a generally longitudinal guiding portion, an inwardly angled flank portion, and a generally longitudinal harnessing portion.

Claim 17 depends from claim 16, further comprising a pair of stirrups, each one of said pair of stirrups being mounted for longitudinal adjustment along a corresponding stirrup-holding portion.

Accordingly, it is respectfully requested that the rejection be reconsidered and that claims 14-17 be allowed.

Claim 9 stands rejected under 35 U.S.C. § 103a as being allegedly unpatentable over Gaines in view of Stein et al. Gaines is cited for a wheel assembly for a sulky having a wheel, "a set of tubular spokes, and a rim; and a pair of substantially planar covers mounted on opposite

¹⁷ *supra*, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*

¹⁸ *supra*, MPEP § 716.01.

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sides of the wheel and substantially covering the tubular spokes.” Stein is cited for a sulky having an arch, a seat mounted to the arch, and a rail on each side of the seat, and a pair of wheels.

Neither Gaines nor Stein et al., alone or in any proper combination, teach or suggest to one of ordinary skill in the art the sulky as claimed in amended claim 9, wherein each wheel assembly includes a wheel and a pair of substantially planar covers mounted on the wheel and substantially covering the wheel. As noted above, Gaines describes a single wheel cover for covering both sides of a wheel, not a pair of wheel covers, as claimed in claim 9. Gaines does not disclose a pair of wheel covers which are mounted to the wheel, as claimed in claim 9. Rather, Gaines appears to describe a “kick guard” (col. 2, ll. 62-69) which is a “rigid unitary assemblage” (col. 3, ll. 8-9) and fixed to the sulky frame by a strap 29 (col. 3, ll. 35-41) and is mounted not to the wheel, but is sandwiched between nuts 20, 21 and the outer races of the wheel bearings 22, 23 (col. 3, ll. 10-15).

Moreover, Gaines does not describe “substantially planar wheel covers” as claimed in claim 9. The Gaines kick guard is shaped substantially like a hollow disc to fit over the wheel. Additionally, the kick guard disclosed by Gaines does not cover the spokes at the bottom of the wheel. In contrast, claim 9 requires that the pair of planar wheel covers “substantially” cover the spokes. For at least these reasons, the invention claimed in claim 9 is patentable over Gaines. Accordingly, it is respectfully requested that the rejection be reconsidered and claim 9 allowed.

Claim 12 stands rejected under 35 U.S.C. § 103a as being allegedly unpatentable over Gaines. Gaines is directed to a wheel covering for a sulky having a wheel and a pair of substantially planar covers fastened to the wheel with screw fasteners.

Claim 12 depends from claim 10 and adds the limitation, wherein the covers are mounted to the wheel using hook and loop fasteners. These references fail to teach that in the racing sulky environment, the time between races can be short, and it is beneficial to have equipment that is easily and quickly assembled. Hook and loop fasteners are therefore advantageous in the racing sulky environment because hook and loop fasteners do not require tools to attach and/or remove. Claim 12 as amended is supported in paragraphs 0030 and 0033.

Accordingly, it is respectfully requested that the rejection be reconsidered and claim 12 allowed.

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Conclusion

For at least the foregoing reasons, it is respectfully submitted that the examiner has failed to meet the burden of establishing a prima facie case of anticipation of any of the claims on appeal, therefore, reversal and remand is respectfully requested.

Dated this 7th day of April, 2006.

Respectfully submitted,



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